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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,582

08/05/2003

Ladislav Lettovsky

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05/06/2005

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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,582

Applicant(s)

LETOVSKY ET AL.

Examiner

Thomas A. Dixon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Interpretation

1. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

The structural limitations of claim 26-50, including client element, processing element and display element are disclosed in Garback (5,237,499) as described herein.

Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

3. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to

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"[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

4. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

5. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

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In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

6. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

7. In the present application, the Claims are to a method for coordinating a plurality of outbound and inbound itineraries, the claims do not recite any automated steps and are not seen to be in the technological arts. As claimed the steps could all be performed by a person, which applicant admits, pg 2. lines 11-29, is old and well known, though complex, as being performed by travel agents.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 7-10, 17-19, 26-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Garback (5,237,499).

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As per Claim 1.

Garback ('499) discloses:

receiving a destination location, a plurality of origin locations and other travel information, wherein each origin location is associated with at least one traveler, see column 5, line 63 – column 6, line 1;

receiving an indication regarding a relative weight between price and schedule for at least some of the outbound and inbound itineraries, see column 6, lines 60-66;

accessing a travel database comprising at least outbound and inbound itineraries between the destination location and the origin locations, see column 6, lines 28-38,

identifying at least one outbound and inbound itinerary between the destination location and each origin location from the travel database based upon the travel information, see column 6, lines 28-38;

determining a suggested outbound and inbound itinerary from the identified itineraries between the destination location and each origin location based upon the indication of the relative weight, see column 6, lines 28-66.

As per Claim 2.

Garback ('499) further discloses:

presenting the suggested outbound and inbound itineraries for review, see column 6, lines 31-33;

receiving an indication that alternative itineraries are desired for at least one of the suggested outbound and inbound itineraries associated with a respective traveler, see column 6, lines 28-67;

presenting other identified outbound and inbound itineraries between the destination location and an origin location for review if an indication is received that alternative itineraries are desired, see column 6, lines 28-67; and

receiving an indication of a selection of at least one of the other identified outbound and inbound itineraries, see column 6, lines 40-67.

As per Claim 3.

Garback ('499) further discloses presenting information associated with the destination location when presenting at least one of the suggested itineraries and the identified itineraries, see figure 4.

As per Claim 7.

Garback ('499) further discloses storing the at least one identified itinerary between the destination location and each origin location, see figure 1 (E. Ticketing file).

As per Claim 8.

Garback ('499) further discloses transmitting at least the suggested itinerary associated with a traveler to the respective traveler, see figure 4.

As per Claim 9.

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Garback ('499) further discloses presenting the identified outbound and inbound itinerary between the destination location and the origin location to the respective traveler, see figure 4.

As per Claim 10.

Garback ('499) further discloses receiving changes to at least one of the suggested outbound and inbound itinerary associated with a traveler to the respective traveler, see figure 4 (Y/N).

As per Claim 17.

Garback ('499) further discloses, receiving hotel rental information, accessing a travel database comprising hotel rental information for the destination location, identifying at least one hotel rental itinerary from the travel database based upon the hotel rental information, presenting the identified at least one hotel rental itinerary for review and receiving an indication of a selected hotel rental itinerary from the at least one hotel rental itinerary, see figure 2B.

As per Claim 18.

Garback ('499) further discloses receiving car rental information, accessing a travel database comprising car rental information for the destination location, identifying at least one car rental itinerary from the travel database based upon the hotel rental information, presenting the identified at least one car rental itinerary for review and receiving an indication of a selected car rental itinerary from the at least one car rental itinerary, see figure 2C.

As per Claim 19.

Garback ('499) further discloses electronic communication among at least two of a travel organizaer and the travelers, see figure 1.

As per Claims 26, 45.

Garback ('499) discloses:
a client element, see figure 1 (22);
a processing element, (10).

As per Claims 27-44, 46-50.

The limitations of these claims are do not introduce additional structure and do not distinguish over the prior art (Garback).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garback (5,237,499).

As per Claims 4, 11.

Garback ('499) further discloses total cost for the individual itinerary, see figure 4 (total cost for the flight) and further a file of group members and ticketing information, but does not specifically disclose determining a total price for all the suggested itineraries.

Addition is old and well known in the mathematical arts for the benefit of determining the totals of numbers.

It would have been obvious to one of ordinary skill in the art at the time the invention to add the individual totals to determine a total price for the group for the benefit of reporting the cost of the conference to the sponsoring organization.

10. Claims 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garback (5,237,499) in view of Acebo et al (6,023,679).

As per Claim 16.

Garback ('499) further discloses a sponsoring organization and employee numbers, but does not specifically disclose:

receiving payment information regarding how the travel costs for each traveler are to be paid; and

transmitting billing information based upon the payment information.

Acebo et al ('679) teaches receiving payment information regarding how the travel costs for each traveler are to be paid, see figure 2A (104); and

transmitting billing information based upon the payment information, see figure 4 for the benefit of collecting money for services rendered.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to receive payment information and transmit billing information as taught by Acebo et al for the benefit of collecting money for services rendered.

11. Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission in view of *In re Venner*, 120 USPQ 192, 194; 262 F2d 91 (CCPA 1958)

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As claimed the steps of organizing group travel could all be performed by a person, which applicant admits, pg 2. lines 11-29, is old and well known, though complex, as being performed by travel agents.

Applicant does not disclose the automation of the method.

In re Venner teaches that it is obvious to automate, for the benefit of easing the burden on employees.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to automate the known method of organizing group travel for the benefit of easing the burden on the travel agency employees.

Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takehara (JP 2001357101) discloses a system for group travel planning.

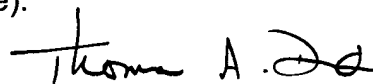
Group Travel Planning teaches a system for group travel planning for travelers from different origins.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3639

May-05